

JAN 5 2005 3:49PM

MOFO 28TH FL

NO. 889 P. 1



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FROM: Robert A. Saltzberg (Reg. No. 36,910)

DATE: January 5, 2005

Number of pages with cover page:	8	Originals will NOT follow.
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### Contents of this Transmission:

Atty Docket No.: 333772000101

Inventor: Akihiko ITO et al.

Application No.: 09/964,211

Filing Date: September 25, 2001

Group Art Unit.: 2133

Examiner: J.C. Kerveros

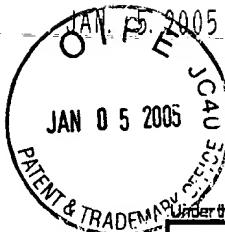
Title: SEMICONDUCTOR DEVICE TESTING APPARATUS AND A TEST TRAY FOR USE  
IN THE TESTING APPARATUS

### Documents Filed:

1. Transmittal (1 page);
2. PTOL-85 w/duplicate copy for fee processing (2 pages); and
3. Comments on the Statement of Reasons for Allowance (4 pages).

Comments: Please see the attached documents. Thank you.

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Approved for use through 07/31/2006. OMB 0551-0031  
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## TRANSMITTAL FORM

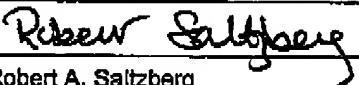
(to be used for all correspondence after initial filing)

		Application Number	09/984,211
		Filing Date	September 25, 2001
		First Named Inventor	Akihiko ITO
		Art Unit	2133
		Examiner Name	J. C. Kerveros
Total Number of Pages in This Submission	7	Attorney Docket Number	333772000101

### ENCLOSURES (Check all that apply)

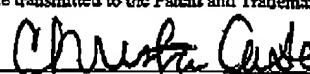
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	<input type="checkbox"/> * PTOL-85 Form (in duplicate, 2 pages total)
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> * Comments on the Statement of Reasons for Allowance (4 pages)
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> * Fax Cover Sheet
<input type="checkbox"/> Reply to Missing Parts/ Incomplete Application	Remarks	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	MORRISON & FOERSTER LLP (Customer No.: 20872)		
Signature			
Printed name	Robert A. Saltzberg		
Date	January 5, 2005	Reg. No.	36,910

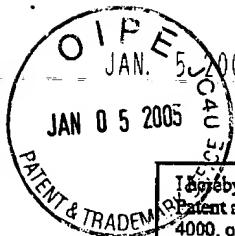
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Dated: January 5, 2005

Signature:  (Christa Carter)

st-1839295

PAGE 2/7 \* RCVD AT 1/5/2005 6:47:55 PM [Eastern Standard Time] \* SVR:USPTO-EFXRF-2/1 \* DNI:7464000 \* CSID:415 2687522 \* DURATION (mm:ss):02:46



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NO. 889 P. 4

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Dated: January 5, 2005

Signature:

  
(Christa Carter)

Docket No.: 333772000101  
(PATENT)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Akihiko ITO et al.

Allowed: October 5, 2004

Application No.: 09/964,211

Confirmation No.: 2026

Filed: September 25, 2001

Art Unit 2133

For: SEMICONDUCTOR DEVICE TESTING  
APPARATUS AND A TEST TRAY FOR  
USE IN THE TESTING APPARATUS

Examiner: J. Kerveros

### COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE UNDER 37 CFR §1.104(E)

Mail Stop ISSUE FEE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant has received the Examiner's Statement of Reasons for Allowance with the October 5, 2004 Notices of Allowance and Allowability regarding the above-identified application. Entry of the Statement into the record should not be construed as any agreement with or acquiescence in the reasoning stated by the Examiner. Each of the claims stands on its own merits and is patentable because of the combination it recites and not because of the presence or absence of any one particular element.

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In particular, Applicants respectfully propose that the Statement of Reasons for Allowance would more accurately reflect the current claims if it read as follows:

"The prior art of record, taken alone or in combination, fail to teach, anticipate, suggest or render obvious the following inventions recited in the allowed independent claims:

With respect to claim 1, a method for testing devices carried by at least two test trays, wherein each tray carries at least one device, the method comprising: transporting a first tray along a first transport path to a first test position; transporting a second tray along a second transport path to a second test position; testing at least one device on the first tray at the first test position; and testing at least one device on the second tray at the second test position.

With respect to claim 22, a method for testing devices carried by at least two test trays, wherein each tray carries at least one device, the method comprising: transporting a first tray to a first test position; transporting a second tray, in parallel to the first tray, to a second test position; testing at least one device on the first tray at the first test position; and testing at least one device on the second tray at the second test position.

With respect to claim 44, a system for testing devices carried by at least two test trays, wherein each tray carries at least one device, the system comprising: a first transport path for transporting a first tray to a first test position; a second transport path for transporting a second tray to a second test position; and a tester for testing at least one device on the first tray at the first test position, and for testing at least one device on the second tray at the second test position.

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With respect to claim 65, a system for testing devices carried by at least two test trays, wherein each tray carries at least one device, the system comprising: at least one transport path for transporting a first tray and a second tray in parallel to a first test position and a second test position, respectively; and a tester for testing at least one device on the first tray at the first test position, and for testing at least one device on the second tray at the second test position.

Consequently, independent claims 1, 22, 44 and 65 are allowed over the prior art of record. Claims 2-21, 23-43, 45-64 and 66-87 directly or indirectly depend from the independent claims, and therefore are also allowable."

The above amended Statement more accurately reflects the language of the current claims. For example, the independent claims recite that each test tray carries at least one device, whereas the Examiner's Statement states that, with respect to claims 1 and 44, each test tray carries one device. Also, with respect to claims 1 and 44, the Examiner states that those claims recite a tester, whereas method claim 1 does not explicitly recite a tester.

If the Examiner agrees with the proposed language, Applicant respectfully requests that the Examiner issue a Supplemental Statement of Reasons for Allowance.

The Examiner's Statement was not prepared by Applicant and only contains the Examiner's possible positions in one or more reasons for allowability. Thus, any interpretation with respect to the Examiner's Statement of Reasons for Allowance should not be imputed to the Applicant.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing

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docket no. 333772000101. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: January 5, 2005

Respectfully submitted,

By Robert Saltzberg  
Robert A. Saltzberg

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